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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/629,218      | 07/29/2003  | Eric Noble           | CARLB-001A          | 5326             |

7590 05/19/2004

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| EXAMINER |
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LERNER, AVRAHAM H

| ART UNIT | PAPER NUMBER |
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3611

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/629,218

**Applicant(s)**

NOBLE ET AL.

**Examiner**

Avraham Lerner

**Art Unit**

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1103.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The Information Disclosure Statement, filed November 10, 2003, is acknowledged and has been considered.

### *Claim Objections*

2. Claims 1-13 are objected to because of the following informalities: "portion" should be added after "lower" in line 2 of claim 1; and the word "motorized" should be inserted before "cycle" in line for consistency with the other claim preambles. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Roatta (U.S. Patent No. 4,744,579).

Roatta discloses a motorized cycle comprising all elements as claimed, including a frame the frame having a first upper portion supporting a seat (not shown) and a handle set (S), and a second lower portion supporting front (29) and rear (20) wheel, the frame further including a generally vertical (to the extent shown by applicant's invention), intermediate frame portion disposed between and interconnecting the upper and lower frame portions; the intermediate

Art Unit: 3611

frame portion extending upwardly from the lower frame portion at a point between the front and rear wheels such that a first void is defined between the front wheel and handle set of the cycle and a second void is defined between the rear wheel and the seat; the seat and handle set being disposed along a first generally horizontal axis; hydraulic steering ((46, 48, 50), and wherein front and rear frame portions of the lower frame have dedicated shock absorbers (22, 36) mounted thereon for engaging with the intermediate frame portion. Regarding claim 3, it is noted that although the seat frame appears to be lower than the handle set of Roatta, when the seat (not shown in the Figs.) is mounted to the cycle it would inherently be situated "along a generally horizontal axis" with the handle set. Also note that regarding claim 5, the vertical line "Y" which arbitrarily defines the direction that the intermediate frame extends does not serve to define over the intermediate frame of Roatta, which also may be considered to extend along a vertical axis.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roatta in view of Sakamoto (U.S. Patent No. 6,685,282 B2).

Roatta discloses a motorized cycle comprising all elements as claimed, as recited above, except for front and rear hydraulic brakes.

Art Unit: 3611

Sakamoto discloses that it is known in the art to provide a motorized cycle with front and rear hydraulic brakes (133, 233).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the motorized cycle of Roatta with the hydraulic brake assembly of Sakamoto in order to improve the safety of the cycle as a whole. Such a modification would, as explicitly stated by Sakamoto in column 1, lines 14-42, would have provided an anti-lock braking system that enables a driver to maintain improved control over the cycle during hard braking by preventing the brakes wheels from locking on a slippery road surface, and therefore would have been obvious to one of ordinary skill.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roatta in view of Hanagan (U.S. Patent No. 3,937,291).

Roatta discloses a motorized cycle comprising all elements as claimed, as recited above, except for powering the cycle with an electric motor.

Hanagan discloses that powering a motorized cycle with an electric motor is a known alternative to using a gas engine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cycle of Roatta with the electric motor of Hanagan in order to, as specifically stated by Hanagan in the paragraph bridging columns 1 and 2, reduce exhaust products that are deleterious to the environment.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roatta.

Roatta discloses a motorized cycle comprising all elements as claimed, as recited above in detail, except for explicitly disclosing the selection of a 50 cc engine or wheels having a

Art Unit: 3611

diameter of 10 inches or less. It would have been obvious to one of ordinary skill in the art to use these design parameters in the cycle of Roatta, since such a modification would have involved a mere change in the size of a component within the level of ordinary skill in the art (*In re Rose*, 105 USPQ 237 (CCPA 1955)) and more specifically it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hashimoto et al. (U.S. Patent No. 4,579,190) discloses specifically that it is known to provide motorized cycles with wheel diameter of between 8 and 12 inches. Latta (U.S. Patent No. 378,253), Sanders (U.S. Patent No. 4,718,688), Yamaguchi et al. (U.S. Patent No. 4,813,511), Ou (U.S. Patent No. 6,588,787 B2), de Cortanze (U.S. Patent No. 4,265,329), Grimm (U.S. Patent No. 6,270,103 B1) and Liao et al. (U.S. Patent No. 6,719,081 B2) disclose cycle frame assemblies having upper, lower, and intermediate frame portions.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avraham Lerner whose telephone number is (703) 308-0423. The examiner can normally be reached on M-F (8:15-5:45) first Wednesday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**AVRAHAM LERNER**  
**PRIMARY EXAMINER**

*A. Lerner 5/17/04*

May 17, 2004